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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/797,870	03/10/2004	Ricko Takahashi	KON-1858	3710
20311	7590	11/28/2005	EXAMINER	
LUCAS & MERCANTI, LLP 475 PARK AVENUE SOUTH 15TH FLOOR NEW YORK, NY 10016			GILLIAM, BARBARA LEE	
			ART UNIT	PAPER NUMBER
			1752	

DATE MAILED: 11/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/797,870

Applicant(s)

TAKAHASHI ET AL.

Examiner

Barbara L. Gilliam

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Amendment***

1. The remarks and declaration filed September 9, 2005 have been entered and fully considered.
2. Claims 1-20 are present.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a. According to Applicant (remarks and declaration of 9/9/2005) and the specification, specific combinations of supports and hydrophilic layers control glossiness and transmission density however independent claim 1 does reflect such specific combinations.

***Double Patenting***

5. Claims 1, 7 and 9 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 6, 8-12 of copending Application No. 10/943,935 (US 2005/0064339 A1). Although the conflicting claims are not identical, they are not patentably distinct from each other

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because it would have been obvious to make a planographic printing plate material comprising a plastic film sheet support such as polyethylene terephthalate or polyethylene naphthalate and provided thereon, a hydrophilic layer and an image formation layer wherein the hydrophilic layer contains metal oxide particles such as colloidal silica and a light to heat conversion material and the image formation layer contains heat-melting particles or heat-conducting particles based on the claims of Miyoshi. Miyoshi does not claim the  $La^*b^*$  value, the transmission density of the hydrophilic layer or the glossiness of the image formation layer however the planographic printing plate material claimed by Miyoshi is expected to have properties consistent with the properties of the present application because the material of Miyoshi has components identical to the components of the present application. MPEP 2112.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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7. Claims 1-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Inoue et al. (EP 1 145 848 A2).

a. The lithographic printing plate precursor of Inoue et al. anticipates the presently claimed printing plate material. Specifically Inoue et al. teach a lithographic printing plate material comprising a hydrophilic support having thereon a heat-sensitive layer containing at least one of a thermoplastic particulate polymer, a particulate polymer having a heat-reactive group and a microcapsule containing a compound having a heat-reactive group incorporated therein (abstract; [0014]-[0062]). The support is dimensionally stable and can be made of various materials including paper, plastic and aluminum ([0108]-[0110]; [0155]). The support may be coated with a hydrophilic layer made of particulate silica and a hydrophilic resin ([0158]-[0164]). An interlayer can further be provided ([0147]; [0172]). A light to heat converting agent can be present in the heat-sensitive layer or layers adjacent thereto ([0088]-[0107]). The lithographic printing plate precursor is exposed to laser beam at a high output, preferably a laser which emits light in the infrared or near infrared, mounted untreated on the cylinder of a printing machine and subject to fountain solution and ink ([0173]-[0176]). Inoue et al. do not teach the  $La^*b^*$  value, the transmission density of the hydrophilic layer or the glossiness of the image formation layer however the planographic printing plate precursor taught by Inoue et al. is expected to have properties consistent with the properties of the present application because the precursor of Inoue et al. has components identical to the components of the present application. MPEP 2112.

***Response to Arguments***

8. Applicant's arguments filed September 9, 2005 have been fully considered but they are not persuasive.

a. In response to applicant's argument that Inoue fails to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., specific combination of supports and hydrophilic layers) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

b. Secondly Applicant has not successfully demonstrated that material of Inoue does not have a transmission density and glossiness within the range of the presently claimed material. Plastic supports are clearly taught by Inoue. Applicant has presented a declaration and is arguing unexpected results however unexpected results cannot be used to overcome a rejection under 35 USC 102. *In re Wiggins*, 488 F.2d 538, 543, 179 USPQ 421, 425 (CCPA 1973).MPEP 2131.04.

***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

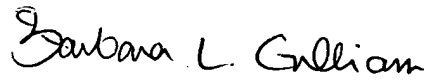
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara L. Gilliam whose telephone number is 571-272-1330. The examiner can normally be reached on Monday through Thursday, 8:00 AM - 5:30 PM.

a. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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b. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Barbara L. Gilliam  
Primary Examiner  
Art Unit 1752

bg  
November 22, 2005